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SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938			IDOWU, OLUGBENGA O	
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			2425	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/903,448	Applicant(s) JOSEPH ET AL.
	Examiner OLUGBENGA IDOWU	Art Unit 2425

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 06 November 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) See Continuation Sheet is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-145)(a)
 Paper No(s)/Mail Date 9/10/2009, 11/02/2009, 03/02/2010
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date: _____
- 5) Notice of Informal Patent Application
 6) Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 68-78, 82 - 83, 85 - 94, 97 - 104, 106 - 116, 120 - 121, 123 - 132, 135 - 142 and 246 - 263.

Continuation of Disposition of Claims: Claims rejected are 68-78, 82 - 83, 85 - 94, 97 - 104, 106 - 116, 120 - 121, 123 - 132, 135 - 142 and 246 - 263.

DETAILED ACTION

Response to Arguments

In response to applicants arguments about the presence of a computing application, it would be understood by one of ordinary skill in the art, from the section about general system configuration in Florin that the AV module receives data and sends it to the decoder 74, the decoder is further described in Col. 9 as decoding data from the vertical blanking interval or special side-band cable channel. As it is very well known that the data carried in the VBI is not displayed on the screen and that the data usually consists of triggers, time codes and other data that facilitate user interaction. Florin does not specifically describe the kind of data in the VBI and this is why Hendricks was brought in for its more specific teaching on encoded digital data or the VBI. The two references are of analogous art because both of them are based on interactive TV systems.

Also, in response to the arguments with regards to detecting at the server, a signal representing a viewer interaction with the interactive information, Florin clearly teaches this limitation in col. 24, lines 33 - 42

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

2. Claims 68-78, 82 – 83, 85 – 94, 97 – 104, 106 – 116, 120 – 121, 123 – 132, 135 – 142 and 246 - 263 rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the situation is set forth in the discussion below in this Office action.

There is no reissue application indicating the error which is relied upon to support the reissue application.

3. The patent sought to be reissued by this application 09 903 448 is involved in litigation. Any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

Claim Rejections - 35 USC § 251

4. Claims 68-78, 82 – 83, 85 – 94, 97 – 104, 106 – 116, 120 – 121, 123 – 132, 135 – 142 and 246 – 263 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

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The "recapture rule," prevents a patentee from regaining, through a reissue patent, subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

Clement discusses a three-step test for analyzing recapture:

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter.

Step 3 is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim.

Substep (3): if the reissue claim is broader in some aspects, but narrower in others, then:

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

The Federal Circuit in *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d at 1350, 75 USPQ2d 1545 (Fed. Cir. 2005) further refined Substep (3) (a) of *Clement* to define "broader in an aspect germane to a prior art rejection" to mean broader with respect to a specific limitation

- (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and
- (2) eliminated in the reissue application claims.

"Surrendered subject matter" is defined in connection with prosecution history estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 USPQ2d 1705, 1710-11 (2002). A patentee's decision to narrow his claims through amendment "may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." *Exhibit Supply*, 315 U.S., at 136-137, 62 S. Ct. 513. "...in determining whether 'surrender' of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent." *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006).

A further opinion, *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003),

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issued by the Board of Appeals and Interferences as a precedential opinion, is also part of the recapture precedent applicable to proceedings before the United States Patent & Trademark Office (USPTO). *Eggert* was entered on May 29, 2003, prior to the Federal Circuit's *North American Container* decision. In *Eggert* the majority held that the surrendered subject matter was the rejected claim **only** rather than the amended portion of the issued claim.

A published precedential opinion of the Board is binding unless the views expressed in an opinion in support of the decision, among a number of things, are inconsistent with a decision of the Federal Circuit. In this case, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*. *See: Ex parte Franklin C. Bradshaw and Thomas L. Soderman*, (Appeal 2006-2744 Bd. Pat. App. & Int. July 19, 2007) (available in Application 09/664,794 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd062744.pdf>); *Ex parte Raanan Liebermann*, (Appeal 2007-0012 Bd. Pat. App. & Int. May 2007) (available in Application 09/603,247 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd070012.pdf>); *Ex parte Willibald Kraus* (Appeal 2005-0841 Bd. Pat. App. & Int. April 2005) (available in Application 08/230,083 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd050841.pdf>)

As set forth in the above BPAI decisions, based on *North American Container* and other court decisions, surrendered subject matter is considered the subject matter of an application claim which was amended or canceled and, on a limitation-by-limitation basis, the territory falling between the scopes of

- (a) the application claim which was canceled or amended and
- (b) the patent claim which was ultimately issued.

Accordingly, the "surrendered subject matter" that may not be recaptured through reissue should *be presumed* to include subject matter broader than the patent claims in a manner directly related to

- (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and
- (2) limitations argued to overcome a patentability rejection without amendment of a claim.

However, when reissue claims are narrower than the patent claims with respect to features other than the surrender generating feature, then the reissue claims may be materially narrowed relative to the claims prosecuted and issued in the patent, thereby avoiding the recapture rule.

As explained in *Hester Industries, Inc., v Stein, Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998), the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention.

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

- (1) which had not been claimed and thus were overlooked during prosecution of the original patent application; and
- (2) which patentably distinguish over the prior art.

In the instant case, the reissue claims satisfy the "recapture rule" preventing a patentee from receiving a reissue patent as per both *Clement three steps test* and *Hester Industries, Inc., v Stein, Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998) as analyzed below:

A: Analysis per *Clement three-step test*:

New claims 68-78, 82 – 83, 85 – 94, 97 – 104, 106 – 116, 120 – 121, 123 – 132, 135 – 142 and 246 – 263 are broader than the patented claims 1-9 because they do not include limitations recited in the patented claims 1-9. There was a surrender of subject matter in the original application prosecution and the broadening of the reissue claims is in the area of the surrendered subject matter. The omitted/broadened limitations in the reissue claims are directed to limitations relied upon by the applicant in the original application to make the claims allowable over prior art (At a minimum, the claims require at least one of

the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,908 application: *a source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted OR a client computer, which includes a packet selector connected to said source for selecting and directing packets containing said auxiliary data representing said video program to a video signal processor and selecting and directing packets containing said associated distributed computing application to a further processor OR further processor including means to assemble said distributed computing application and execute said distributed computing application to form an interactive video program in which execution of said distributed computing application alters said video program OR a source of a time division multiplexed packet signal including a plurality of distributed computing applications, each distributed computing application being repetitively transmitted independent of receiving client computer apparatus, and each of said distributed computing applications being in a form of a series of packets OR a first one of packets of a respective series containing data representing an executable code module and including identification information indicating that the first one of packets of said series contains data representing said executable code module OR the client computer extracts said directory module from the data stream and using data contained in the directory module extracts packets associated with said distributed computing application and builds said distributed computing application and executes said distributed computing application OR read/write memory, coupled to the system bus; a data stream input/output adapter, coupled between the data stream receiver*

and the system bus, for receiving the extracted distributed computing application representative data from the data stream receiver, and storing it in the read/write memory, and having a control output terminal coupled to the selection control input terminal of the data stream selector, for producing the selection control signal; and a processor, coupled to the system bus, for controlling the data stream input/output device to generate a selection control signal selecting a specified one of the plurality of data streams, and for assembling and executing the distributed computing application stored in the read/write memory.). The filed re-issue claims are broader than the original patent claims by not including the surrender-generating limitations (as described above) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

B: Analysis as per *Hester Industries, Inc, v Stein, Inc.*: In order to satisfy the two conditions, the subject matter that materially narrows the reissue claims should be the overlooked aspect of the original invention claimed in the patent. In the instant case, the reissue claims do not include any subject matter of the patented

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claims (independent patented claims 1, 6, 9, 10) but instead the subject matter that materially narrows the reissue claims is directed to a distinct and different invention and it is not the overlooked aspect of the original invention.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 68 – 78, 82 – 83, 85 – 94, 97 – 104, 106 – 116, 120 – 121, 123 – 132, 135 – 142 and 246 - 263 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin, patent number: 5 583 560 in view of Hendricks, patent number: 5 990 927 .

As per claims 68, 87, 101, 106, 125, 139, 246- 248 and 253 – 263, Florin teaches using a server to transmit to a client both a television program and a computing application (providing videos and interactive data to clients, col. 8, lines 52 - 54) display of interactive information associated with the television program while the television program is being displayed at the client (receiving and displaying video and interactive data, col. 8, line 61 – col. 9, line 1);

The interactive information to show or describe an item to a television viewer
(commercials, col. 23, lines 54 - 56)

Detecting, at the server, a signal representing a viewer interaction with the
interactive information, the viewer interaction indicating a selection of the item (server
receiving information, col. 24, lines 33 - 42) and

In response to the viewer interaction, causing an order for the item to be placed
(ordering product, col. 24, lines 8, lines 32 - 34)

Florin does not teach the presence of executable code.

In an analogous art, Hendricks teaches comprising executable code, the executable code to be executed at the client to cause display of interactive information (executable application for user interactions, col. 27, lines 23 - 40)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Florin's interactive system by including a system that executes interactive data for the advantages of improving user's experience while interacting with the system.

As per claims 69, 88, 107 and 126, The combination of Florin and Hendricks teach wherein the viewer interaction causes display of instructions to solicit information necessary to place the order (Florin: requesting PIN from user, col. 24, lines 29 - 32).

As per claims 70, 89, 108 and 127, The combination of Florin and Hendricks teach wherein the information is solicited using one or more of an on-screen display and voice instructions (Florin: requesting PIN, col. 24, lines 29 – 32 Fig. 49, 420).

As per claims 71, 90, 109, 128 and 249, The combination of Florin and Hendricks teach wherein the viewer interaction is by way of a single command (Florin: pressing the select button, col. 23, lines 56 - 61).

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As per claims 72, 91, 102, 110, 129, 140 and 250, The combination of Florin and Hendricks teach wherein the single command is selected from the group consisting of: selecting of a single button (Florin: pressing the select button, col. 23, lines 56 - 61); and pressing of a single button on a TV remote control.

As per claims 73, 92, 103, 111, 130, 141 and 251, The combination of Florin and Hendricks teach wherein causing the order to be placed is achieved by using: information related to the item and viewer related personal information (Florin: sending order to headend, col. 9, lines 9 - 12).

As per claims 74, 93, 112 and 131, The combination of Florin and Hendricks teach wherein the personal information includes at least one of the group consisting of the viewer's name, address, method of payment and payment account number (Florin: confirming order and delivery time, col. 24, lines 40 - 41).

As per claims 75, 94, 113, 132 and 252, The combination of Florin and Hendricks teach wherein the personal information is stored in memory at the client (Florin: memory, col. 9, line 65 – col. 10, line 1).

As per claims 76 and 114, The combination of Florin and Hendricks teach wherein the system further includes a local computer in communication with the client and associated storage and wherein the method further comprises:

using the client to retrieve information from one or more of the local computer and the associated storage (Florin: external CD-ROM, col. 10, lines 13 - 17)

As per claims 77 and 115, The combination of Florin and Hendricks teach wherein the method further comprises: controlling the client by means of the local computer (Florin: external CD-ROM, col. 10, lines 13 - 17).

As per claims 78 and 116, The combination of Florin and Hendricks teach wherein the local computer is part of a local area network (Florin: external CD-ROM, col. 10, lines 13 - 17).

As per claims 82, 97, 120 and 135, The combination of Florin and Hendricks teach further comprising:

sending an order confirmation to the user to confirm the order (Florin: order confirmation, col. 24, lines 40 - 41)

As per claims 83, 98, 104, 121, 136 and 142, The combination of Florin and Hendricks teach wherein the server is configured to provide data in a series of multiplexed packets, ones of which contain data representing the video, and others of which represent the computing application (Florin: sending video and data to users, col. 10, lines 32 – 44, col. 8, line 52 - col. 9, line 4).

As per claims 85, 99, 123 and 137, The combination of Florin and Hendricks teach wherein the client includes a client computer and an auxiliary processor, the method comprising:

using the auxiliary data processor to process data representing the video, and using the client computer to execute the computing application (Florin: processing, col. 8, line 52 – col. 9, line 13).

As per claims 86, 100, 124 and 138, The combination of Florin and Hendricks teach wherein the client computer and the auxiliary data processor are contained in a set top box (Florin: transceiver 54, col. 8, line 1)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 79 -81, 95 – 96, 117 – 119 and 133 – 134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin, patent number: 5 583 560 in view of Hendricks, patent number: 5 990 927 in further view of Coddington, patent number: 5 410 343.

As per claims 79 -81, 95 – 96, 117 – 119 and 133 – 134, The combination of Florin and Hendricks teach an interactive system that transmits video and data to a client and allows the client to order products.

The combination does not teach a system that transmits the user's orders through a telephone system.

In an analogous art, Coddington teaches a system that communicates with the server through a telephone system (ADSL and PSTN systems, col. 6, lines 11 - 47)

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combination of Florin and Hendricks by including a communication system based on telephone infrastructure, as described in Coddington's VOD system, for the advantages of making the system compatible with one way transmission systems.

5. Claims 84, 105, 122 and 143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin, patent number: 5 583 560 in view of Hendricks, patent number: 5 990 927 in further view of Banker, patent number: US 5 485 221.

As per claims 84, 105, 122 and 143, The combination of Florin and Hendricks teach an interactive system that transmits video and data to a client and allows the client to order products.

The combination does not teach a system that transmits the data multiple times.

In an analogous art, Banker teaches wherein the computing application is repetitively transmitted during times that the video is transmitted (repeatedly transmitting data, col. 17, lines 40 - 47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Florin and Hendricks by retransmitting data to a user, as described by Bunker's television system, for the advantages of ensuring correct reception of data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUGBENGA IDOWU whose telephone number is (571)270-1450. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 5712727527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/OLUGBENGA IDOWU/
Examiner, Art Unit 2425

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